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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,134	12/15/2000	Dante Pellegrini	22571-166778 RSB	8140
26694 7590 01/12/2007 VENABLE LLP P.O. BOX 34385 WASHINGTON, DC 20043-9998			EXAMINER BORLINGHAUS, JASON M	
			ART UNIT	PAPER NUMBER
			3693	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/12/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/736,134

Applicant(s)

PELLEGRINI, DANTE

Examiner

Jason M. Borlinghaus

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 17 is objected to because of the following informalities: typographical error. Claim 17 claims to dependent upon the "method of claim 14," however Claim 14 is a system. Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

This rejection is based on the new guidelines issued by the Patent & Trademark Office and further consideration of the claims in light of such guidelines.

With respect to Claims 1, 10 and 11, Examiner finds these claims to lack a tangible result. Examiner notes that the focus of this analysis is on the result, not the individual steps. With respect to a tangible result, the process must produce a real-world result. The final step of independent Claims 1, 10 and 11 state, "performing a function related to transferring ownership...". As the final step of the independent claims does not produce a real-world result, the Examiner finds that there is no tangible result produced.

Dependent claims are rejected based upon their dependence from rejected claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 – 5, 7 – 11, 14 – 18, 20 – 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanter (US Patent 5,537,314) in view of Rush (US Patent 6,966,836).

Regarding Claims 1 - 3, Kanter discloses a method for transferring ownership of an asset, comprising the steps of:

- issuing redeemable tokens (points) having defined redemption values (dollar amounts) to one or more participants over a network (communication lines), wherein the participants interface with the network using wired or wireless devices (computer processing unit), and wherein

each issued redeemable token (point) is associated with a participant (participant). (see col. 4, lines 39 – 67; col. 16, lines 4 – 35; fig. 2);

- performing a function (purchasing) related to transferring an ownership right to the asset (merchandise) to a participant who is associated with a selected redeemable token (points). (see col. 4, lines 39 - 67); and
- specifying a redemption value for the asset (amount of points) for the asset (merchandise). (see col. 5, lines 22 – 28).

Kanter also discloses a method for transferring ownership of an asset, comprising:

- probabilistically (via raffle) selecting at least one token (entry). (see col. 16, lines 38 – 56 and col. 20, lines 19, 41).

It would have been obvious to one ordinary skill in the art at the time the invention was made to have modified Kanter by incorporating the ability to utilize a redeemable token, as disclosed by Kanter, as a raffle entry, as disclosed by Kanter, allowing for the combination of two types of incentive programs, redeemable tokens and raffle entries, into one incentive vehicle.

Kanter does not teach underlined claim limitations – a method comprising the steps of:

- probabilistically selecting at least one redeemable token, upon or after redemption value of the issued redeemable tokens reaches a predefined cumulative value;

- specifying a redemption value for the asset that corresponds to the predefined cumulative value; and
- wherein the asset is equal to the predefined cumulative value.

Rush discloses a method for transferring ownership of an asset, comprising the steps of:

- issuing redeemable tokens (prize tokens) having defined redemption values (each token can be exchanged for \$1) to one or more participants over a network (Internet), wherein the participants interface with the network using wired or wireless devices, and wherein each issued redeemable token (token) is associated with a participant (player account). (see col. 1, line 65 – col. 3, line 63);
- probabilistically (via lottery) selecting at least one redeemable token (token), upon or after a predefined time period. (see col. 4, line 63 – col. 5, line 6);
- monitoring the quantity of redeemable tokens issued. (see col. 3, line 64 – col. 4, line 7);
- the issued redeemable tokens possess a predefined cumulative value. (see col. 3, line 64 – col. 4, line 7); and
- specifying a redemption value for the asset (fixed total prize value) that corresponds to the cumulative value of tokens (fixed value of all tokens). (see col. 4, line 63 – col. 5, line 6;).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Kanter by incorporating the monitoring of the cumulative quantity/value of issued tokens and basing the redemption value of the asset on said cumulative quantity/value, as disclosed by Rush, allowing for consistent and controlled gameplay, as disclosed by Rush.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow for any unit of measurement for the timing of the probabilistic selection that the inventor desired, such as measurement in time or cumulative outstanding tokens. *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow for relationship between the asset and the predefined cumulative value that the inventor desired, such as having the asset being less, equal or more than the predefined cumulative value, especially as Rush indicates that there is a fixed asset value and a fixed cumulative token value. *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

Regarding Claims 4 – 5, Kanter discloses a method wherein:

- the redeemable tokens (“points”) are issued in response to a participant meeting an incentive criterion (“incentive program”). (see col. 5, lines 10 – 27).

Kanter does not teach the underlined claim limitation – a method wherein:

- the redeemable tokens are issued in response to a participant purchasing the redeemable tokens for a specified price.

Examiner takes Official Notice that it is old and well known in the art of games of chance and to purchases tokens, points and/or entries at a specified price for entrance into a probabilistic award program, such as purchasing raffle tickets for a specified price for entrance into a raffle drawing, is old and well known in the art of games of chance. It would have been obvious to one of ordinary skill in the art to have modified Kanter and Rush to have incorporated the ability to purchase tokens, as is old and well known in the art, allowing for participants an additional traditional method through which to gain entrance to the program.

Regarding Claims 7 – 9, Claims 7 – 9 recite similar limitations and/or would have been obvious based upon claims rejected above, Claims 1 – 5, and are therefore rejected using the same art and rationale as applied in the rejection of Claims 1 – 5.

Regarding Claims 10 - 11, Claims 10 - 11 recite similar limitations and/or would have been obvious based upon claims rejected above, Claims 1 – 5, and are therefore rejected using the same art and rationale as applied in the rejection of Claims 1 – 5.

Regarding Claims 14 – 18, 20 – 21 and 23, further system claims would have been obvious from method claims rejected above, Claims 1 – 5, 7 – 9 and 11, and are therefore rejected using the same art and rationale.

Claims 6, 12 – 13, 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanter and Rush, as applied to Claims 5, 11, 18 and 21 above, and

further in view of Walker (Walker, Leslie. *Where You Can Get Rich Click*. *The Washington Post*. Washington, DC. November 18, 1999. p. E01).

Regarding Claim 6, Kanter does not teach underlined limitation - a method wherein:

- the incentive criterion requires browsing one or more web pages.

Walker discloses a method wherein:

- the incentive criterion requires browsing one or more web pages.
(Iwon.com awards “points” as part of an incentive program for viewing and/or clicking through web page content – see p. E01).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Kanter and Rush by incorporating the token issuance incentive criterion being the browsing of web pages, as disclosed by Walker, as token issuance premised upon the browsing of web pages was already utilized at the time of the invention as an advertising technique designed to lure additional viewers of Internet content.

Regarding Claim 12, Claim 12 recites similar limitations and/or would have been obvious based upon claim rejected above, Claim 6, and are therefore rejected using the same art and rationale as applied in the rejection of Claims 1 – 5.

Regarding Claim 13, Claim 13 recites similar limitations and/or would have been obvious based upon claims rejected above, Claim 1 - 5, and are therefore rejected using the same art and rationale as applied in the rejection of Claims 1 – 5.

Regarding Claims 19 and 22, further system claims would have been obvious from method claims rejected above, Claim 6, and are therefore rejected using the same art and rationale.

Response to Arguments

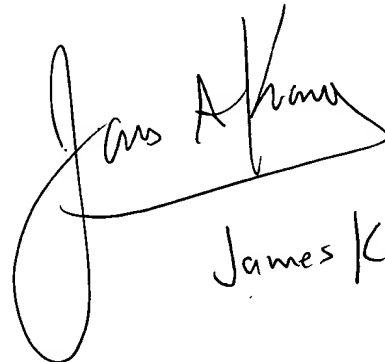
Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 1/8/07
James Kramer